

the movement of the mechanical arm to a cone of no more than 35 degrees as Ognier's device is inherently capable of such movement for the purpose intended." The case law governing the standards of proof needed in showing anticipation are set forth below.

The factual determination of anticipation requires the disclosure in a single reference of every element of the claimed invention. See: Ex parte Levy, 17 USPQ2d 1461 (PTO Bd. of Pat. App. and Int. 1990). Furthermore, it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference. See Lindermann Maschinenfabrik GmbH v. American Hoist and Derrick, 221 USPQ 481 (Fed. Cir. 1984). In determining anticipation, functional language, preambles, and language in "whereby", "thereby", and "adapted to" clauses cannot be disregarded. Pac-Tec, Inc. v. Amerace Corp., 14 USPQ2d 1871 (CAFC 1990).

In the rejection of Claim 16, the Examiner recognizes that the ball joints in Ognier are known to be rotatable about 360 degrees. Since the Examiner is relying solely on Ognier here, Ognier **must expressly teach** this so called "obvious mechanical expedient" and also **must expressly teach** the so called "purpose intended", which is to restrict the range of motion of the ball joints to a cone of about 35°. ~~That is the law.~~ Where is the Examiner getting this "purpose intended" from? Certainly not from Ognier. There is absolutely nothing in Ognier that expressly teaches the restriction of rotation of the ball joints to a cone angle of no greater than about 35°. Thus, Ognier **does not** disclose every element of the claimed invention. Therefore, Ognier **does not** pass the Ex parte Levy test for anticipation put forth by the PTO Board of Patent Appeals and Interferences. Where is this necessary teaching in Ognier? The Examiner must look at Fig. 1 of Ognier, where there is shown a rotation of the ball joint 108a of 45 degrees. Quite obviously, the ball joint 108a could have been rotated even further through an angle of 90 degrees. We invite the Examiner to check this out with a protractor. The ball joint 103 can also be rotated through an angle of 90 degrees. ~~There is nothing in Ognier that teaches or discloses~~ limiting the movement of the arm components or the surgical instrument to a cone of no more than 35°. This rejection is clearly erroneous and should be reconsidered and withdrawn.

THE §103 REJECTION OF CLAIMS 11-16:

Claims 11-16 stand rejected as being obvious over Ognier in view of Osypka. In this obviousness rejection, the Examiner has incorrectly labeled certain components of Ognier in attempting to compare them to the limitations in the claims in question.

The following statements made by the Examiner in assessing Ognier in the rejection are incorrect:

- a) "105b of Ognier is a swiveling and rotatable seat for the accessory instruments".

According to the reference, 105b is a distal segment of the rigid arm 105 which segment is connected to a proximal segment 105a of the arm 105. Support for the instrument 4 is provided by a ball 103 which is mounted on the distal segment 105b of the arm 105;

b) the mechanical arm of Ognier is operative to prevent body cavity wall rupture during orientation of the instrument in the body cavity. This statement is completely unsupported by the Ognier reference;

c) the elasticity of the mechanical arm 105 is controlled by the material that the mechanical arm is formed from. The mechanical arm segments are formed from a rigid material, not an elastic material;

d) the elasticity of the mechanical arm is the result of swiveling joints(108, 108a) formed in the mechanical arm. In actuality, the joints render the arm flexible, but not elastic. It is also noted that the joints 108 and 108a are locked up once the arm is properly positioned. The locking mechanisms are rings 25 and 36 which are selectively pressed against the ball joints 108a and 108 selectively (see Figs. 3 and 5). Once the ball joints are locked up, the arm is no longer flexible, it is rigid. It never is "elastic", as claimed in the instant claims; and

e) the swiveling joints are biased by torsion springs (40c, figure 5), wherein rupture of the body cavity wall is prevented by restricting the degree of operative motion of the mechanical arm. The spring that the Examiner refers to as numeral 40c is not a torsion spring. It is a piston return spring for the piston 40. It biases the piston 40 away from the secondary piston 50. We trust that the Examiner knows what a torsion spring is. A watch spring is an example of a torsion spring. A piston return spring is not an example of a torsion spring.

We have pointed out five different Examiner mischaracterizations of what the Ognier patent actually discloses, which mischaracterizations are put forth in the grounds for the §103 rejections. On page 4 of the Office Action, the Examiner repeats the "obvious mechanical expedient ++++ for the purpose intended" argument regarding the claimed requirement that movement of the mechanical arm and seat be restricted to a cone having an included angle of no more than about 35 degrees. We specifically insist that the Examiner indicate where in Ognier he finds this "purpose intended" which would be accomplished by restricting movement of any of the ball joints in Ognier to a cone having an included angle of no more than about 35 degrees. FIG. 1 of Ognier clearly indicates that such a limited range of motion is not provided by the Ognier assembly. Note that the ball joint 108 can be moved through an angle of more than 90 degrees as is clearly shown in FIG. 1 of Ognier.

The Office Action is quite clear in that the Examiner is only using the Ognier reference in

rejecting Claims 11, 12 and 16, and is using the combination of Ognier and Osypka in rejecting Claims 13-15 since he is relying on Osypka solely for a teaching of the use of "resilient connectors" which are first claimed in claim 13 of the instant application. That said, it is obvious that the Examiner has ignored Claim 12 which requires that the mechanical arm be a coil spring. Ognier does not show a coil spring mechanical arm. The Examiner cannot ignore claim limitations.

In referring to Osypka, the Examiner specifically refers to Col. 7, lines 53-55 and lines 58-60 as providing a teaching of a mechanical arm of elastic type made of elastomeric material such as a torsion spring to better aid in the active deployment of the arms from a constrained (SIC "constrained"?) position to an unstressed deployed position. These "mechanical arms" that the Examiner is referring to in Osypka are actually electrodes. They are made of shape memory alloys such as nickel or titanium alloys or a spring metal. The Osypka device is intended to be used as an implantable cardio version and defibrillation lead for applying electrical energy to the heart in case of erratic heart beats. The Examiner argues that it would have been obvious to modify the arms and joints of Ognier to employ the materials that the electrodes of Osypka are formed from.

The Examiner sums up his grounds for rejecting the claims in question on page 5 of the Office Action by alleging that: "Such modification would have involved a mere substitution of one well known type of mechanical arm with another which is thought to be well within the ambit of one of ordinary skill in the art.". We submit that it is naive to argue that one of ordinary skill in the art endoscopy or coeloscopy interventions (Ognier) would make the arms 105, 105a and 105b of Ognier out the same material as the defibrillation lead electrodes 116a-116d for applying electrical energy to the heart which are disclosed in Osypka. What is the motivation found in either reference for making that substitution? We submit that there is none.

We submit that the §103 rejections of Claims 11-16 should be reconsidered and withdrawn.

Respectfully submitted,



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